

MURRAY - USSN 09/973,955

REMARKS

This Amendment is intended to be fully responsive to the outstanding Final Office Action. Reconsideration of the outstanding Final Office Action and entrance of this Amendment are respectfully requested.

Applicant respectfully traverses the outstanding rejections in the July 9, 2003 Final Office Action, but the above amendments have been made to expedite prosecution of the subject application while the applicant reserves the right to refile the previously rejected claims in subsequent continuation applications claiming priority to the above-identified application. By the amendments above, claims 4, 24, 25, 29 and 30 have been rewritten into independent form and claims 1-3 have been canceled. Thus, claims 4, 24, 25, 29 and 30 have not been narrowed. Also, claims 5, 13-15, 17, 19, 20, 23, 26 and 27, which were dependent upon a claim that is now cancelled, have been amended to correct their dependencies.

Specification

A new paragraph has been added to page 27 of the Specification to describe in verbiage what is clearly shown in the drawings and what is inherent in the specification as filed. No new matter has been added and entrance of the paragraph is respectfully requested.

Drawings

The two attached sheets of drawings include changes to Figs. 4 and 5. The first sheet contains Fig. 4 and the second sheet contains Fig. 5. These sheets replace the originally-filed sheets including Figs. 4 and 5. The changes to both Figs. 4 and 5 consist only of additional reference numbers and lead lines, which correspond to reference numbers added in the

MURRAY – USSN 09/973,955

amendment to the Specification presented above. The changes to Fig. 4 consist of the inclusion of new reference numbers 312, 314 and 316 and their corresponding lead lines. The changes to Fig. 5 consist of the inclusion of new reference numbers 152, 158, 310, 314, 316, 318, and 320. The illustrations themselves have not been changed and nothing has been deleted. No new matter has been added. Approval for the replacement pages is respectfully requested.

Claim Rejections – 35 USC § 103

In paragraph 2 of the Office Action, claims 22-26 and 28-30 are rejected as being unpatentable over Jones et al. in view of Bayerische and Choi. This rejection is respectfully traversed.

The Office Action relies upon Bayerische for providing a plastic film to the blade of Jones et al. but then states that "Jones et al. & Bayerische do not disclose...said film having a longitudinally curved portion along a longitudinal direction of the blade." The Office Action then states that Choi discloses a concavo-convex configuration, but the Office Action remains silent as to how Choi, or any other reference, provides a longitudinally curved portion along a longitudinal direction of the blade to the combination of Jones et al. and Bayerische.

The Office Action also remains silent as to claim 22, which recites that a portion of the blade having the film is "curved in a longitudinal direction of said blade." Support for this language can be found, for example, in Figs. 4 and 5 of the subject application.

The Office Action further remains silent as to claims 24 and 29, each of which recite that "said film has a longitudinally curved portion along a longitudinal direction of said blade when said blade is fully retracted within said housing assembly." Again, support for this language can be found, for example, in Figs. 4 and 5 of the subject application.

Both Jones (Fig. 4) and Bayerische (Fig. 2) appear to illustrate that each of their respective tapes remain flat until reaching a spool and being wound upon itself. Also, Bayerische explicitly states that its fitting 9, "does not

MURRAY – USSN 09/973,955

adjust to the curve of the winding formed in the frame." (Translation of Bayerische, Col. 2, last five lines (emphasis added)). Bayerische also discloses the length of the fitting 9 as being the length "x" (Fig.2), which terminates before the curve of the winding.

Since the Jones and Bayerische tapes appear to only curve longitudinally during winding around the reel and since Bayerische explicitly teaches against extending the fitting 9 into the curve of the winding, Jones and Bayerische fail to satisfy any of claims 22, 24, and 29.

Also, Choi fails to make up for all of the deficiencies of Jones and Bayerische. Even if it was assumed that Choi discloses that the tape 12 has a longitudinal curved portion, the disclosure of Bayerische teaches against such a combination. That is, the disclosure of Bayerische discloses only a flat fitting 9 and states that the tape covered by the fitting and the fitting should not be subjected to any bending alternating stresses (Translation of Bayerische, Col. 3, lines 6-9). Such stresses would certainly occur if the fitting itself was curved. Further, Bayerische states that the fitting "does not adjust to the curve of the winding" (Translation of Bayerische, Col. 2, last five lines, emphasis added) and, clearly, the curved section of tape illustrated in Fig. 2 of Choi is adjusting to the curve of the winding.

Claims 24 and 29 further require that the film has a longitudinally curved portion when the blade "is fully retracted within said housing assembly," which is further not disclosed or suggested in the prior art.

The Office Action also remains silent as to claims 25 and 30, which each recite:

said blade having a portion that is wrapped around said reel when said blade is fully retracted within said housing assembly and is curved along a longitudinal direction of said blade, and
said film extending on said free end portion of said blade to a position on said portion of said blade that has been wrapped around said reel.

MURRAY - USSN 09/973,955

Support for language can be found, for example, on page 26 of the Specification, lines 11-27.

Reconsideration of claims 25 and 30 is also respectfully requested since a retractable rule assembly as set forth in claims 25 and 30 is not disclosed or suggested in the prior art. For example, as set forth above, Bayerische specifically states that the fitting 9 does *not* extend into the winding of the measuring tape. In particular, Bayerische states:

It must be taken into consideration that such a fitting, even if it consists of a flexible material, does not adjust to the curve of the winding formed in the frame. Rather, if the fitting end should be included in the winding, a new kink location would be created instead.

Translation of Bayerische, Col. 2, last five lines (emphasis added).

That is, Bayerische explicitly states that the fitting 9 "does not adjust to the curve of the winding formed in the frame" and discusses a particular problem that would arise if it did. Thus, regardless of the fact that there exists no motivation to provide a film extending to a position on a portion of the blade that has been wrapped around the reel, Bayerische expressly teaches away from any proposed combination that could result in a rule assembly that could satisfy claims 25 and 30.

Thus, it is submitted that it would be inappropriate to combine the prior art references to derive the combination as forth in claims 25 and 30 as this would directly contradict the explicit teaching in Bayerische that its fitting "does not adjust to the curve of the winding formed in the frame." (Translation of Bayerische, Col. 2, lines 53-54 (emphasis added)). Thus, the combination proposed in the Office Action for rejecting claims 25 and 30 is improper.

Additionally, Bayerische discloses a fitting 9 that extends for a length "x," which "essentially corresponds to the distance between the slotted guide 5 of the frame 2 and the attachment point of the tape end applied here to the winding 18 of the tape 4 as a tangent." (Translation of Bayerische, Col. 4, penultimate paragraph.) This length of "x" is illustrated in Figs. 1 and 2 of Bayerische and clearly illustrates that the length "x," and, thus, the length of

MURRAY - USSN 09/973,955

the fitting 9, does not extend to a position on the portion of the blade that has been wrapped around the drum 3. Thus, no combination relying upon Bayerische can result in a fitting that extends to a position on the portion of the blade that has been wrapped around the reel, as claimed.

Accordingly, withdrawal of the rejection is respectfully requested.

In paragraph 4 of the Office Action, claims 3-12 are rejected as being unpatentable over Jones et al. in view of Bayerische, Choi, Kobayashi, and Bradshaw. This rejection is respectfully traversed.

Claim 4 recites that the film "extends from the free end of the blade to approximately the point where the blade is in abutting volute configuration when said blade is fully retracted."

The Office Action states, regarding claim 4, that each of the references relied upon disclose the film extending to approximately the point where the blade is in abutting volute configuration and specifically cites Fig. 3 of Bayerische. First, none of Jones et al, Choi, Kobayashi and Bradshaw discloses or suggests a film as claimed and none is relied upon for such in the Office Action. Only Bayerische is relied upon in the Office Action for disclosing a film.

However, if both the concavo-convex configuration of Choi and a fitting 9 extending the entire length "X" as disclosed in Bayerische were provided to Jones et al. the resulting fitting would necessarily bend or curve at the portion of the fitting close to the winding. However, Bayerische teaches away from such bending, making such a combination improper. Employing the concavo-convex configuration of Choi and extending the fitting 9 to the winding would necessarily require a curving of the fitting as it approaches the winding as seen in Fig. 2 of Choi. In other words, the fitting would bend as it and its corresponding extent of tape adjust to the curve of the winding. However, Bayerische explicitly teaches away from such bending when it states that the fitting "does not adjust to the curve of the winding." (Translation, Col. 2, last five lines, emphasis added.)

MURRAY - USSN 09/973,955

Also, any fitting 9 of Bayerische having a concavo-convex configuration at "approximately the point where the blade is in abutting volute configuration" as required by claim 4 will necessarily begin to flatten transversely prior to winding around the reel so that the tape can be wound in a flat configuration. As seen in Figs. 4 and 6 of the subject application, a tape measure with a concavo-convex configuration is wound in a flat configuration. (See also, for example, Applicant's Specification, p. 9, lines 17-20.) Therefore, just prior to bending, at "approximately the point where the blade is in abutting volute configuration" any fitting 9 of Bayerische having a concavo-convex configuration will bend longitudinally as it begins to curve to adjust to the curve of the winding (See Fig. 2 of Choi) and will also bend transversely as the concavo-convex configuration begins to flatten for winding around the reel. This longitudinal and transverse bending upon a fitting is prohibited by the Bayerische patent. Therefore, the combination is improper.

The remaining claims depend from and further limit one of the above-mentioned independent claims and are allowable at least for the reasons set forth above.

Further, even prior to the rewriting of the claims as set forth above, pending claims 1-32 were allowable over the prior art of record, thus, further supporting the allowability of the claims pending after entrance of this amendment. In particular, the rejection to claim 1 combines Jones et al. and Bayerische to provide the flexible fitting 9 as disclosed in Bayerische to the tape of Jones et al., while further combining Choi to provide a concavo-convex configuration to the tape of Jones et al.

The Office Action states that "Jones et al. and Bayerische do not disclose said elongated blade housing a concave-convex configuration when extended from said housing assembly." Instead, Jones et al. and Bayerische disclose only flat tapes and do not disclose or suggest using a concavo-convex configuration. Additionally, neither Jones et al. nor Bayerische disclose or suggest tape measures with a coil spring to rotate the reel as required in the claims. Therefore, neither Jones et al. nor Bayerische present

MURRAY - USSN 09/973,955

the potential problem of the blade structure being compromised after repeated spring retraction of the blade into the housing as is the case with tape measures having coil springs.

Also, as stated above, Bayerische makes clear that its fitting 9 is intended to extend from the free end of the tape to the point at which the tape begins to wind on the reel, which is illustrated as length "x" in the figures. (Translation of Bayerische, Col. 3, lines 1-5 and Col. 4, penultimate full paragraph.) Bayerische further states that the fitting 9 "does not adjust to the curve of the winding" of the tape (Translation of Bayerische, Col. 2, last paragraph, lines 11-14) so that the tape covered by the fitting 9 and the fitting 9 are "not being subjected to any bending alternating stresses at a small bending radius" (Translation of Bayerische, Col. 3, lines 6-9).

Therefore, in addition to there being no motivation for providing a concave-convex configuration to the fitting 9 of Bayerische in any of the prior art, Bayerische teaches away from any bending of fitting 9 and, thus, teaches away from shaping the material that forms fitting 9 into a concave-convex configuration as suggested in the Office Action. The proposed combination would bend the material that forms fitting 9 of Bayerische both longitudinally and transversely, as explained above, as the concave-convex configuration flattens transversely and bends longitudinally to be wound around the reel. Thus, the proposed combination would subject the material forming fitting 9 and its corresponding length of tape to bending stresses and would necessarily destroy the intended purpose of the material of fitting 9 of Bayerische. Thus, the rejection is improper.

Even if it was assumed that the material of fitting 9 of Bayerische could be provided to Jones et al., the subsequent curving and bending of the tape and fitting of the Jones-Bayerische combination so that it was longitudinally curved as in Choi would inflict the fitting of the combination and its corresponding tape to bending stresses. This would be contrary to the intended purpose of Bayerische and would destroy the intended purpose of the fitting on the combined Jones-Bayerische apparatus.

MURRAY - USSN 09/973,955

Additionally, even if it was assumed that the concave-convex configuration of Choi could be provided to Jones et al., the presence of the concave-convex configuration would prohibit providing the material of fitting 9 of Bayerische to the Jones-Choi combination. Again, such a further combination would result in bending the material of the fitting 9 of Bayerische and be contrary to the disclosure of Bayerische.

The Office Action also states that it would have been obvious to "pre-form and mold the film disclosed by Bayerische in a manner taught by Choi," (paragraph 2 of Office Action) and states that "no bending stresses would be possible if both the blade and film were pre-molded in a concavo-convex configuration, as suggested in the teaching of Choi" (paragraph 6 of Office Action). However, no such motivation exists in Choi. That is, Choi neither discloses nor suggests any type of pre-forming or molding. Additionally, as mentioned above, as a fitting with a concavo-convex configuration approaches the reel for winding, it will flatten transversely and bend longitudinally in anticipation of its winding around the reel. Thus, even if a fitting was pre-molded for a concavo-convex configuration, bending would exist as the fitting approached the reel and began to flatten and curve for winding. Accordingly, withdrawal of the rejection is respectfully requested.

In paragraph 3 of the Office Action, claim 2 is rejected as being unpatentable over Jones et al., Bayerische and Choi and further in view of Kobayashi. This rejection is respectfully traversed at least the same reasons set forth above.

In paragraph 4 of the Office Action, claims 3-12 are rejected as being unpatentable over Jones et al., Bayerische and Choi and further in view of Bradshaw. This rejection is respectfully traversed for at least the same reasons set forth above.

Additionally, with respect to claims 7 and 9, the Office Action states that the combined references and, presumably, Jones et al. in particular disclose a "U-shaped hook portion (20) that is bent at a generally right angle from an end (19) of said mounting portion." However, the hook 20 of Jones et

MURRAY - USSN 09/973,955

al. is not bent at a generally right angle to rectangular ring 19. Rectangular ring 19 "is attached at one end to a hook 20" (col. 2, lines 64-65). Additionally, Figures 1 and 4 of Jones et al. disclose a rectangular ring 19 and a hook 20 that are illustrated consistent with two parts that are movable relative to each other and do not illustrate a hook portion that is bent generally at a right angle from an end of the mounting portion as claimed. Thus, the characterization of the prior art with respect to the rejection of claims 7 and 9 is inaccurate and the rejection is, thus, additionally improper.

Additionally, claim 9 recites that the film is adhered to the blade "a length that is within a range of from approximately 2" to approximately 12"." This is further not disclosed or suggested in the prior art of record.

In paragraph 5 of the Office Action, claims 15 and 16 are rejected as being unpatentable over Jones et al., Bayerische and Choi and further in view of Beeber. This rejection is respectfully traversed for at least the same reasons set forth above.

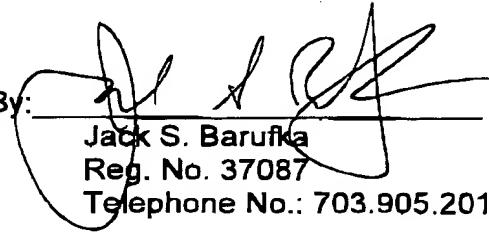
* * *

MURRAY - USSN 09/973,955

In view of the foregoing, all claims are believed to be in form for allowance, and such action is hereby solicited. If any points remain in issue that the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,
Pillsbury Winthrop LLP

By:



Jack S. Barufka
Reg. No. 37087
Telephone No.: 703.905.2012

JSB/TPH/mll
P.O. Box 10500
1600 Tysons Boulevard
McLean, VA 22101
703.905.2000
703.905.2500 fax

FAX RECEIVED

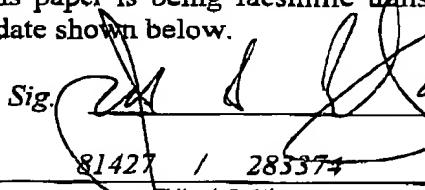
Attachment: Two Replacement Sheets (Fig. 4 and Fig. 5).

NOV 10 2003

TECHNOLGY CENTER 2800

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this paper is being facsimile transmitted to the Patent and Trademark Office on the date shown below.

Name Jack S. BarufkaSig. Date Nov. 6, 2003

81427 / 283374

C# / M#